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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PROCEEDINGS

USHER: Calendar Number 14, Appeal Number 2009-1218, Mr. Skerpon.

JUDGE LEBOVITZ: Yes, Mr. Skerpon?

MR. SKERPON: Good afternoon, Your Honors. How are you doing?

JUDGE LEBOVITZ: Yes, Mr. Skerpon, if you could introduce yourself and the appeal number and serial number, and then we'll have about 20 minutes.

MR. SKERPON: Okay. Thank you. My name is Joe Skerpon. I am here on behalf of the Mockrys, two independent inventors who have a passion for the game of baseball. Let's see. The Application Number is 09/878,860 and the Appeal Number is 2009-1218. Thank you. Let's see. The invention is very simple as I'm sure you having read the briefs you understand.

JUDGE LEBOVITZ: We were hoping you were going to bring an excerpt.

MR. SKERPON: Yeah. Well, I can't say for sure if you go on MLB's website, I don't know that they're continuing to use it, but back when I was first engaged, they had the product of this method available for sale. And I think tab 4 on my Brief is an exhibit of that. But, in any event, the invention is simply as I characterize it, an objective way of repackaging a baseball game. As I said, very simple. And, unfortunately, that simplicity I think enters into the evaluation of its patentability; and, from my perspective, at least, when I look at everything as a whole, I think the Examiner has used a

1 little too much hindsight in evaluating what is specifically claimed in our
2 application.

3 JUDGE FREDMAN: Can I ask a question about the claim to begin
4 with?

5 MR. SKERPON: Yes.

6 JUDGE FREDMAN: Could you just direct us? You have the phrase
7 "consisting essentially of," as your transition phrase.

8 MR. SKERPON: In claim 23.

9 JUDGE FREDMAN: That's 23 for the editing.

10 MR. SKERPON: That's right.

11 JUDGE FREDMAN: Do you ever tell us what the material and
12 basically novel features "consisting essentially of" are for PPG?

13 MR. SKERPON: Yeah. From at least the Inventor's standpoint it's
14 having the last pitch of each player shown. I mean, it follows immediately
15 in the claim, what is the essential and novel characteristics of that invention.

16 JUDGE FREDMAN: But in PPG when they didn't define that they
17 basically treated it as comprising, and so my question is why shouldn't we
18 here treat it since it isn't. I don't think it's in the spec, unless I'm
19 misunderstanding the spec. It's not interpreted why should we not treat it as
20 comprising.

21 MR. SKERPON: Well, because again I don't think it should be
22 treated as comprising. I think the application defines the invention clearly as
23 the last pitch. I think through prosecution. I don't know how many times
24 I've said that through the prosecution of this case. I think clearly the file
25 history would not bear out an analysis of that claim as comprising. I mean
26 there's no doubt in my mind.

1 JUDGE FREDMAN: You could have just deleted the word
2 essentially.

3 MR. SKERPON: What's that?

4 JUDGE FREDMAN: You could at least have said "consisting of" and
5 then you wouldn't have had this problem.

6 MR. SKERPON: Well, the only problem of "consisting of" and just
7 to be frank is that if, for example -- and I think it's in my Brief -- there's a
8 paragraph where I say, you know, you cut a short vision of the code sending
9 in a signal or somebody in the stands. What defines, I think, our invention
10 from the art is the Inventors require objectively that each last pitch is part of
11 this record. Now, if you were to interpret the claim as comprising, then the
12 claim would embrace the whole record of the baseball game.

13 JUDGE FREDMAN: For some smaller version.

14 MR. SKERPON: Well, no. It would not cover a smaller version
15 because you wouldn't have every pitch, the last pitch. And that's what I
16 think the fallacy of the primary reference. And I guess just to make it brief I
17 would just rely on the Examiner filed a paper, an advisory in August of 2008
18 after we were done filing our briefs, where he provided a transcript of an
19 interview that was done touting this Pro Quest product.

20 And if you read that, you'll recognize that they clearly didn't do what
21 we did, so I think the 102 rejection is clearly misapplied, and we'll quibble
22 about 103. You know, where my position is, but in any event, just a couple
23 of sentences on page 2 of 4. There's a quote. "There's no time to keep that
24 weird pick-off play now, says Winter. Too bad." So they cut out a pick-off
25 play. That has to be part of our recording. A couple of lines down: "Since
26 the computer glitch has yet prevented Winter from committing any action to

1 tape, he decides to wait until the end of the game to make any final decisions
2 on what plays to keep." You don't make any decision on what plays to keep
3 in the claimed method. It's dictated. It's objective.

4 Down a little bit further at the end of that bridging pages 2 and 3 he
5 instructs editor Armstrong to preserve the top of the first inning, the entire
6 6th inning, and the bottom of the 9th, along with the graphic. Again, that
7 would not be included in the recording that's made using the method of the
8 Inventor's invention.

9 JUDGE LEBOVITZ: Is "consisting essentially of" an issue in this
10 case?

11 MR. SKERPON: It wasn't with the Examiner, at least unless you read
12 something into his Answer. Plus, if you turn, then we have claim 24, which
13 is sort of the other way I tried to claim it just to emphasize what we were
14 doing, and the transitional phrase is "By deleting substantially all of the
15 game action other than."

16 JUDGE FREDMAN: Right.

17 MR. SKERPON: And, you know, I think that if you don't buy
18 "consisting essentially of" as capturing it, that clearly captures it would be
19 my position.

20 JUDGE FREDMAN: Yeah..

21 MR. SKERPON: So just three points, and one of the points I think
22 I've already made; and, that is that Pro Quest doesn't anticipate clearly. And
23 from our standpoint, I think it's only with hindsight that you think it makes it
24 obvious. The second point is that the Examiner's Answer himself, I think,
25 highlights the hindsight nature of the evaluation insofar as we went through,
26 and I don't know how thick this file is but this was a tortured prosecution.

1 One, the Applicants were denied their original filing date and went
2 through a bunch of petitions to get the original filing date, et cetera, so the
3 prosecution stretches from 2001 to now with no RCEs and anything. It's just
4 a single prosecution. But in the Answer on pages 7, I guess, and 8, the
5 Examiner captures the essence of the invention when he breaks it down.
6 This doesn't appear in any of the original office actions.

7 It shows up first in his Answer, after having read our papers over and
8 over and over again. He now, you know, breaks down the baseball game
9 and the two things and says it's obvious to include all of A and none of B.
10 Well, you know, in hindsight I can't argue with that. But from our
11 standpoint, and that goes to the last point I want to make, is the technology
12 was available to do this from probably the mid-'80s.

13 The Internet came into vogue in the mid-'90s. It didn't get introduced
14 as a product until MLB introduced in 2002. They announced it in 2001.
15 Our Inventors met with MLB in the summer of 2000 just after they filed
16 their provisional and disclosed it to them. Now, they disclosed it not in
17 confidence, and MLB was free to do with it and there was no patent on it.
18 But the Examiner wants to ignore that evidence because one, MLB's touting
19 of it is hyperbole and makes no difference. It's just advertising to the
20 technology for doing it has been there all along. And I agree with that.

21 It's been there forever, but no one repackaged a baseball game in this
22 way, and it was a product that MLB sold. As I said, Tab 4, and I think the
23 Examiner's Answer says he doesn't know that MLB did that. And I don't
24 know. I didn't know any other way really of making it of record. I guess I
25 could have put in my own declaration, which I didn't do. I mean, because

1 we had given the Examiner the website, so he could have paid the 4.95 for a
2 one-month subscription and looked at it himself.

3 We had given him that. But I think Exhibit 4 shows it, and that is it's
4 watch every pay-off pitch, every hit run and out. About 88 pitches; I mean,
5 what MLB did was exactly what we asked them, you know, or asked them to
6 take from our Applicants and do.

7 JUDGE WALSH: Could you address one of the harder questions?

8 MR. SKERPON: Yes.

9 JUDGE WALSH: At least for me is to understand why the invention
10 is not basically a highlight tape or a highlight show, because I've been
11 wondering about highlight being in the eye of the beholder. What are the
12 highlights?

13 MR. SKERPON: Well, and I would agree with that.

14 JUDGE WALSH: So, would you put that that?

15 MR. SKERPON: And I agree with that. Highlights are in the eye of
16 the beholder, and every beholder may have a difference that are highlights.
17 But the point is the highlight isn't going to be the last pitch to every batter
18 that bats. You know, if, let's say, there's 27 strike-outs. You're not going to
19 show in a highlight film; and, I don't think anyone you ask would say they're
20 highlight.

21 JUDGE FREDMAN: That's anybody.

22 MR. SKERPON: There's a strike-out pitch to every one of those 27
23 batters.

24 JUDGE FREDMAN: Say 28. Is 27 a perfect game? Someone might
25 show that, 28 strike-outs or 27 strike-outs and a walk.

1 MR. SKERPON: There's been perfect games, and no one's distilled
2 the game down to all 27 strike-outs. Or even all 27 outs, strike-outs or not.

3 JUDGE FREDMAN: I think the daily show does that all the time. At
4 least not games. You know, you show the same thing repeatedly.

5 MR. SKERPON: You said the same thing over and over and over
6 again. Yeah, okay. For comedic value, I can see that. But, again, in a
7 highlight reel or a highlight, let's say no runs are scored until the 5th inning.
8 They may show a couple outs, great catches, great play. But they're not
9 going to show every routine ground out, every routine fly out, every,
10 however it takes place. No one. I guess I can't believe anyone would think
11 that a highlight reel consists of that entire, you know.

12 JUDGE LEBOVITZ: What is the Examiner's reason? So you're point
13 is that -- I don't want to put words in your mouth -- looking at element 1, the
14 final pitch thrown to every batter and action resulting from the final pitch,
15 you're saying that at least is one of the novelties of claim 23. Right?

16 MR. SKERPON: Yeah, and retaining that, retaining that and edited
17 film. Right. Or edited video.

18 JUDGE LEBOVITZ: Right. What was the Examiner's reason?

19 MR. SKERPON: Well, as I understand it his basic reason was what
20 you keep is a matter of choice, that it's old to edit games and what you
21 maintain in your edited video is a matter of choice. And anything that's a
22 matter of choice is obvious.

23 JUDGE LEBOVITZ: And that's why Judge Walsh was asking about
24 the highlights?

25 MR. SKERPON: I think. Yeah.

26 JUDGE LEBOVITZ: Okay. And your point is?

1 MR. SKERPON: Well, my point is that whenever you use old
2 technology in a new way, it's always a matter of choice. The question
3 whether it's an obvious choice or a non-obvious choice to me, you know.
4 Any method that you all are passing on a series of steps, whether what
5 temperature you run at, what you do anything at. It's a matter of choice. It's
6 always a matter of choice.

7 The question is whether the resulting product is something that
8 somebody of ordinary skill in the art would have thought was obvious; and,
9 here, I think the final product is a non-obvious product. No one would. In
10 hindsight I can't argue with it. I mean in hindsight, yeah, and you could also
11 argue, well, no one's ever going to want this. But MLB shows that that's not
12 the case. I mean, they introduced the product. You know, and you had it
13 subscribed for like five or six bucks a month a few years ago to have access
14 to the games.

15 JUDGE LEBOVITZ: Well, all the Examiner needs is a reason under
16 KSR, a logical, fact-based reason. And I'm still not understanding what the
17 Examiner's reason for picking the final pitch to every batter.

18 MR. SKERPON: Well, I don't know.

19 JUDGE LEBOVITZ: And that's what you're saying is.

20 MR. SKERPON: Other than his position it's a matter of choice,
21 although he also has taken the position that Pro Quest shows it. I mean he's
22 made a rejection under 102, so at least in his opinion it also anticipates what
23 we're claiming.

24 JUDGE LEBOVITZ: Okay.

25 MR. SKERPON: And from my standpoint I think it's clear that it
26 doesn't anticipate the method we embrace, but.

1 JUDGE LEBOVITZ: And Pro Quest was actually an article
2 published.

3 MR. SKERPON: That's right. It was an article about a show that was
4 being, I think, produced in San Francisco, as my recollection is right. That's
5 right.

6 JUDGE FREDMAN: The Giants, presumably?

7 MR. SKERPON: I think the Athletics. Oakland, but they were doing
8 Athletics, I think. They may have been doing both the home teams. They
9 consider both home teams out there, so. But, and that's all I really add. As
10 you know from the record, and this is my own problem, but there was an
11 allowance in this long ago, and the Inventors were all excited and thought
12 we had something. And it was withdrawn, I don't know, about a year and a
13 half later. So my poor guys had been waiting years and years for a final
14 resolution of this thing. So I welcome whatever decision at least I can
15 finally tell them. They've gotten the consideration that they've been looking
16 for all along.

17 JUDGE LEBOVITZ: Sure.

18 MR. SKERPON: So I thank you very much.

19 JUDGE LEBOVITZ: Okay. Any further questions?

20 MR. SKERPON: No. That's really I just wanted to make those
21 points. I think everything is in the Brief and, so, I just wanted to make those
22 three points from my standpoint.

23 JUDGE LEBOVITZ: Hearing over and we can go off the record.

24 (The hearing was concluded at 2:05 p.m.)
25